

REMARKS

INTRODUCTION:

In accordance with the foregoing, claim 35 has been canceled without prejudice or disclaimer. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-34, 36, and 37 are pending and under consideration.

ALLOWABLE SUBJECT MATTER:

In the Office Action, at page 6, item 7, the Examiner indicated that claims 10-11 and 15-34 would be allowable if rewritten in independent form. Applicant holds rewriting of these claims in abeyance until the Examiner has had the opportunity to review the arguments presented herein.

Additionally, though the Examiner listed claims 10, 11, and 15-34 as being allowable, the Examiner rejected claims 32-34 under §103. Further, the Examiner never explicitly rejected claims 5, 6, or 12-14, but did reject claim 10 under §112. Further still, in the Office Action Summary, the Examiner listed claims 5, 6, and 10-31 as being objected to. To advance prosecution, Applicants have assumed that the Examiner intended to indicate that at least claims 5, 6, and 11-31 would be allowable if rewritten in independent form, and that claim 10 would also be similarly allowable if the §112 issue is resolved.

OBJECTIONS TO THE DRAWINGS:

In the Office Action, at page 2, item 1, the Examiner objected to the drawings. In view of the accompanying Replacement FIG. 5, in which pulleys 115 and motor 116 are now shown, Applicants respectfully submit that the outstanding drawing objections should be resolved. Applicants respectfully submit that no new matter has been entered. Support for the amended drawings can be found, e.g., in paragraph 45.

Reconsideration and withdrawal of the outstanding objection to the drawings is respectfully requested.

REJECTION UNDER 35 U.S.C. §112:

In the Office Action, at page 6, item 9, the Examiner rejected claim 10 under 35 U.S.C. §112, second paragraph, for the reasons set forth therein. The reasons for the rejection are set

forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Claim 8, from which claim 10 depends, recites: "...a connecting unit, wherein the print unit is mounted on the moving body, and the scan unit is selectively mounted on the moving body by the connecting unit to scan the first paper."

Further, Applicants respectfully note that FIG. 13 illustrates a scan unit 430 that is not mounted on the head moving body 423.

REJECTION UNDER 35 U.S.C. §102:

In the Office Action, at page 3, item 3, the Examiner rejected claims 1-4, 7-9, and 35-37 under 35 U.S.C. §102 (b) as being anticipated by Egashira et al., (US 5,567,068 – hereinafter Egashira). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Applicants note that the §102 rejection lists claims 1-4, but the Examiner did not explicitly list any §102 rejection for claims 2 or 3, and instead, rejected claims 2 and 3 under 35 U.S.C. §103. Accordingly, to advance prosecution, Applicants have assumed that the Examiner intended only to reject claims 1, 4, 7-9, and 35-37 under §102.

Claim 35 has been cancelled without prejudice or disclaimer.

The MPEP states: "[t]o anticipate a claim, the reference must teach every element of the claim." (MPEP 2131).

The MPEP then quotes: "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (Quoted in MPEP 2131).

The MPEP further quotes "[t]he elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required." *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). (Quoted in MPEP 2131).

Independent claim 1 recites: "...a moving body that is movable; a scan unit, moved by the moving body to scan a first paper; and a print unit, moved by the moving body to print on a second paper."

Independent claim 36 recites: "...a moving body that is movable; a scan unit, to scan a first paper; and a print unit, to print on a second paper, wherein one of the scan unit or the print

unit is connected to the moving body, and the remaining one of the scan unit or the print unit is selectively connected to the moving body."

And independent claim 37 recites: "...a print unit, to print on a second paper; and a scan unit, selectively connected to the print unit, to scan a first paper, and reduce a load on the print unit during printing."

Egashira discloses a combination scanner and printer housed in a device body 41. The device has first and second paper trays 31 and 32 that admit paper to first and second paper transfer paths 39 and 40. Printing unit 25 is disposed on the second paper transfer path 40, and scanner/copy processing unit 26 is disposed on the first paper transfer path 39. The device also has first and second covers 34 and 35 that provide access to the first and second paper transfer paths 39 and 40, respectively. (See Egashira, at FIGS. 1-3, and col. 3, line 61 to col. 6, line 2).

Though it is not clear from the rejection, given the disclosure of Egashira and the disposition of scanner/copy processing unit 26 and the image transferring part 25e of the printing unit 25 on the second cover 35, it appears that the Examiner is asserting that the second cover 35 corresponds to the claimed moving body. Applicants respectfully disagree.

While second cover 35 does indeed move, if the second cover 35 is in any position other than the one depicted in FIG. 3, neither the scanner/copy processing unit 26 nor the printing unit 25 can operate. And Egashira neither discloses nor suggests that either scanner/copy processing unit 26 or image transferring part 25e is moveable with respect to the second cover 35.

Thus, contrary to the Examiner's assertions, Applicants respectfully submit that there is no basis to assert that Egashira discloses or suggests a moving body that moves a scan unit to scan a first paper and moves a print unit to print on a second paper, as required by claim 1. For similar reasons, Applicants respectfully submit that Egashira discloses or suggests the features recited in independent claims 36 and 37.

Additionally, regarding claim 7, we believe that there is no basis to assert that Egashira discloses or suggests that scanner/copy processing unit 26 and the image transferring part 25e are "selectively connected."

Further, regarding claim 8, we believe that there is no basis to assert that Egashira discloses or suggests that scanner/copy processing unit 26 is selectively mounted to the second cover 35.

Thus, Egashira fails to disclose every element of the claims, arranged as required by the

claims.

Accordingly, Applicants respectfully submit that the Examiner has not provided sufficient evidence to maintain a *prima facie* anticipation rejection of claims 1, 4, 7-9, and 35-37.

Therefore, Applicants respectfully submit that independent claim 1 patentably distinguishes over the cited art, and should be allowable for at least the above-mentioned reasons. Further, Applicants respectfully submit that claims 4, and 7-9, which ultimately depend from independent claim 1, should be allowable for at least the same reasons as claim 1, as well as for the additional features recited therein.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action, at page 4, item 5, the Examiner rejected claims 2 and 3 under 35 U.S.C. §103(a) as being unpatentable over Egashira in view of Ahn, (US 6,519,047 – hereinafter Ahn). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 5, item 6, the Examiner rejected claims 32-34 under 35 U.S.C. §103(a) as being unpatentable over Egashira in view of Lopez (U.S. 6,414,760 – hereinafter Lopez). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Applicants respectfully submit that claims 2, 3, and 32-34, which ultimately depend from independent claim 1, should be allowable for at least the same reasons as claim 1, as well as for the additional features recited therein.

CONCLUSION:

In accordance with the foregoing, Applicants respectfully submit that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the cited art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

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If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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AMENDMENT TO THE DRAWINGS:

The attached drawing includes changes to FIG. 5. The sheet containing FIG. 5 replaces the original FIG. 5. In FIG. 5, pulleys 115 and motor 116 are now shown. Applicants respectfully submit that no new matter has been entered. Support for the amended drawings can be found, e.g., in paragraph 45.